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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,551	08/29/2000	Jonathan B. Orlick	ST/044	8362

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EXAMINER	
MA, JOHNNY	

ART UNIT	PAPER NUMBER
2623	

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/555,551	ORLICK, JONATHAN B.	
	Examiner	Art Unit	
	Johnny Ma	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 May 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-10,12,13,15-19,21 and 24-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-10,12,13,15-19,21 and 24-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 5/17/2006 have been fully considered but they are not persuasive.

Applicant traverses the Examiner's rejections of claims 1 and 13 as being unpatentable over Ellis in view of Zigmond. Applicant first argues that the examiner has failed to provide a motivation to combine the references because "increased revenue is not the 'objective teaching' necessary to provide motivation to combine Ellis and Zigmond" (Remarks, pg. 4); "the Examiner has not provided any indication why one of ordinary skill in the art would be motivated to combine Ellis's system and method for displaying a graphic overlay as part of an electronic program guide that may include advertisements with Zigmond's system and method for selecting and inserting advertisements into video programming" (Remarks, pg. 5), and because "[t]hese two references refer to completely different and unrelated advertising techniques" (Remarks, pg. 5). The examiner respectfully disagrees. As noted by Applicant, the previous Office Action stated:

> *"[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Ellis et al. overlay including advertisements with the Zigmond et al. ad database and ad links for the purpose of generating increased advertisement revenue for program providers and providing advertisements that are more likely to appeal to the user and thus increase advertising effectiveness for the advertisers."*

With regard to Applicant's argument related to increased revenue, the Examiner respectfully submits that Applicant has not addressed the motivation to combine in it's entirety. Specifically,

it appears that Applicant does not traverse "providing advertisements that are more likely to appeal to the user." Furthermore, the Zigmond et al. reference specifically teaches the desirability of targeting advertisements to viewers that are more likely to be receptive to the commercial message (Zigmond 1:23-43; 2:10-15). The examiner respectfully submits that such a desirability to use targeted advertisements satisfies the "objective teaching" necessary to provide motivation to combine the references. The Zigmond et al. teaching of the desirability of targeted advertisements also provides a motivation to modify the Ellis displaying a graphic overlay with the Zigmond system and method for selecting advertisements for insertion. The Ellis reference is silent as to the implementation of advertisements into the disclosed BROWSE feature and one of ordinary skill in the art at the time the invention was made would have motivated to rely on the well known use of targeted advertisements, as taught by Zigmond, for implementing the Ellis system. Regarding Applicant's argument that the Ellis and Zigmond references refer to completely different and unrelated advertising techniques, it is noted that both the Ellis et al. and Zigmond et al. references teach systems for presenting advertisements to system users wherein the Zigmond et al. reference teaches a specific method of presentation, targeted advertising. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, this obviousness rejection only takes into account knowledge within the level of ordinary skill at the time the invention was made as evidenced by the Zigmond teaching of the desirability of targeted advertisements as discussed above.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 3-7, 12-13, 15-19, 21, 28-30, and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US 2003/0204847 A1 of record) in further view of Zigmond et al. (US 6,698,020 B1 of record).

As to claim 1, note the Ellis et al. reference that discloses an electronic television program guide schedule system and method with remote product ordering. The claimed "a television program schedule database" is met by "[t]he microcontroller 16 uses the received program schedule information to build a database by storing the data in appropriately organized records in dynamic random access memory (DRAM) 18" (Ellis [0097]). The claimed " comprising television program schedule information, informational messages, and information

links that link the informational messages to the television program schedule information" is met by "[t]he schedule information [...] includes the name of the program and program start/stop time" (Ellis [0129]) and "the microcontroller first searches the program schedule database in, for example, the DRAM 18 to retrieve the programming information for the currently tuned channel 52 corresponding to the current time..." (Ellis [0119]) and in the BROWSE mode "a graphic overlay 111 is generated, as in the FLIP mode, with program schedule information for the currently tuned channel 112..." (Ellis 0126]) wherein it is inherent that the television program schedule information and informational messages be linked in order for them to be properly displayed to the user. Note, the Ellis et al. reference discloses that the BROWSE feature may incorporate advertisements (Ellis [0127]). However, the Ellis et al. reference is silent as to how the advertisements are incorporated into the BROWSE feature. Now note the Zigmond et al. reference that discloses a method for intelligent ad insertion. The claimed "an advertising database comprising advertising messages and advertisement links that link the advertising messages to the television program schedule information" is met by "advertisement source 62 may be a local repository having stored therein a plurality of advertisements" (Zigmond 8:3-5) wherein "the ad selection criteria 83 [links] may select specific advertisements according to a particular program being viewed" (Zigmond 12:49-51). The claimed "select an advertising message from the advertising database that is linked to the displayed television program by the advertisement link" is also met by "the ad selection criteria 83 [links] may select specific advertisements according to a particular program being viewed" (Zigmond 12:49-51). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Ellis et al. overlay including advertisements

with the Zigmond et al. ad database and ad links for the purpose of generating increased advertisement revenue for program providers and providing advertisements that are more likely to appeal to the user and thus increase advertising effectiveness for the advertisers. The claimed "and television equipment configured to: display a television program on a substantially full portion of a display monitor" is met by "[i]n the BROWSE mode, the user is provided with the ability to scan through program schedule information for any channel, including, but not limited to, the channel being viewed, while at the same time continuing to view the TV program previously selected" (Ellis [0126]). The claimed "select an informational message from the television program schedule database that is linked to the television program schedule information by the information link" is met by the selecting of the corresponding program information (informational message) from the television program schedule database (Ellis [0119,0126-0129). The claimed "display a pop up window overlaid on the displayed television program" is met by the display of a graphic overlay while at the same time continuing to view the TV program previously selected (Ellis [0126]). The claimed "the pop up window including the selected advertising message and the selected informational message" is met by the Ellis et al. and Zigmond et al. combination as discussed above teaching an overlay (pop up window) including advertisements. The claimed "wherein the television program is simultaneously displayed with both the informational message and the advertising message" is met by displaying an overview while at the same time continuing to view the TV program previously selected" (Ellis [0126]).

As to claim 3, the claimed "wherein the selected informational message relates to the displayed television program" is met by "a graphic overlay 111 is generated, as in the FLIP mode, with program schedule information for the currently tuned channel 112" (Ellis [0126]).

As to claim 4, the claimed "wherein the selected informational message relates to later programming on a channel of the displayed television program" is met by "[i]n order to view programming information for later or earlier times, the user employs the left and right direction arrows 43B. As a consequence, the system will display future program schedule information for the particular channel previously selected by the up and down direction arrows, whether it is the channel currently being viewed or any other available channel" (Ellis [0129]).

As to claim 5, please see rejection of claim 3.

As to claim 6, the claimed "further comprising displaying a composite of an EPG and an advertising message overlaid on the displayed television program" is met by the Ellis et al. and Zigmond et al. combination as discussed in the rejection of claim 1.

As to claim 7, the claimed "further comprising displaying an EPG overlaid on the displayed television program" is met by "the user is provided with the ability to scan through program schedule information for any channel, including, but not limited to, the channel being viewed, while at the same time continuing to view the TV program previously selected" (Ellis [0126]).

As to claim 12, the claimed "in which the selected advertising message is about a product or service" is met by the Ellis et al. and Zigmond et al. combination as discussed in the rejection of claim 1 wherein ads may comprise goods or service (Zigmond 14:25-26).

As to claims 13, 15-19, and 21, please see rejections of claims 1, 3-7, and 12 respectively.

As to claim 28, please see rejection of claim 1.

As to claim 29, the claimed "wherein a different advertising message is selected each time the pop up window is displayed." The Ellis et al. reference does not specifically disclose the display of a different advertising message each time the pop up window is displayed. Nevertheless, the examiner gives Official Notice that it is notoriously well known in the art to display different advertisements to users for the purpose of maximizing advertising revenue and to increase the likelihood that a user will view and advertised product or service of interest to the viewer and for the further purpose of providing variety to a user. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Ellis et al. display electronic program guide overlay with advertisements accordingly for the above stated advantages.

As to claim 30, the claimed "wherein a different advertising message is selected and displayed after a predetermined time." The Ellis et al. reference does not specifically disclose the display of a different advertising message after a predetermined time. Nevertheless, the examiner gives Official Notice that it is notoriously well known in the art to replace advertisements for the purpose of maximizing advertising revenue and to increase the likelihood that a user will view and advertised product or service of interest to the viewer and for the further purpose of providing variety to a user. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Ellis et al. display electronic program guide overlay with advertisements accordingly for the above stated advantages.

As to claim 35-37, please see rejection of claim 28-30 respectively.

4. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US 2003/0204847 A1 of record) in further view of Zigmond et al. (US 6,698,020 B1 of record) and Alten et al. (US 5,635,978 of record).

As to claim 8, note the Ellis et al. and Zigmond et al. combination distributing non-video program guide and advertising data to set top boxes where it is stored. However, the Ellis et al. reference is silent as to the storage of EPG data including background color. Now note the Alten reference that discloses the storage of bitmaps in the system for use as "mood background" viewing (Alten 11:34-38). Alten specifically discloses the use of a "nighttime view" (Alten 11:42) and (Fig. 5c) as an example. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Ellis et al. EPG display with the Alten et al. background coloring for the purpose of easing the monotony of viewing program listings.

As to claim 9, please see rejection of claim 8.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US 2003/0204847 A1 of record) in further view of Zigmond et al. (US 6,698,020 B1 of record), Alten et al. (US 5,635,978 of record), and Marshall et al. (US 5,828,420 of record).

As to claim 10, note the Ellis et al. and Alten et al. combination teaches an EPG guide including stored background color values. However, the Ellis et al. and Alten et al. combination is silent as to the use of a transparent value for the background color. Now note the Marshall et al. reference that discloses an EPG that uses a transparent value for the background of the EPG (Fig. 9). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Ellis et al. and Alten et al.

combination with the Marshall et al. transparent background color for the purpose of maintaining the full screen view of the television program while viewing the program listing for the viewer's entertainment.

6. Claims 25 and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US 2003/0204847 A1 of record) in further view of Zigmond et al. (US 6,698,020 B1 of record) and Macrae et al. (US 2003/0208756 A1 of record).

As to claim 25, the claimed "wherein the selected advertising message is about an upcoming television program or event." Note, the Ellis et al. reference discloses advertising messages (Ellis [0127]). However, the Ellis et al. reference is silent as to advertising messages about an upcoming television program or event. Now note the Macrae et al. reference that discloses a method and system for displaying targeted advertisements in an electronic program guide. The claimed "wherein the selected advertising message is about an upcoming television program or event" is met by advertisements displaying information about a future-scheduled television program" (Macrae [0214]). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Ellis et al. advertisements with the Macrae et al. future-programming advertisements for the purpose of promoting certain programs to a user and allowing a user to easily instruct the EPG to record the future-scheduled program (Macrae [0214).

As to claim 32, please see rejection of claim 25.

7. Claims 26-27 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US 2003/0204847 A1 of record) in further view of Zigmond et al. (US 6,698,020 B1 of record) and Schein et al. (US 2003/0208758 A1 of record).

As to claims 26 and 27, the claimed "wherein the selected advertising message is related to a sponsor of the displayed television program" and "wherein the selected advertising message promotes products and services of the sponsor." Note the Ellis et al. reference discloses an overlay with advertisements. However, the Ellis et al. reference does not specifically disclose advertising messages relating to a television program sponsor. Now note the Schein et al. reference that discloses a method and system for displaying panel advertisements in an electronic program guide wherein advertisement messages may advertise programs or products from program sponsors, etc. (Schein et al. [0081]). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Knudson et al. electronic program guide advertisements with the Schein et al. program sponsor advertisements for the purpose of providing a program sponsor with an additional benefit of increasing exposure of viewers to its' products/services and an additional means revenue.

As to claims 33 and 34, please see the rejections of claim 26 and 27.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnny Ma whose telephone number is (571) 272-7351. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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